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OFFICE OF PETITIONS

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| In re | : |
| Fukumoto, et al. | : |
| Application No. 09/744,426 | : DECISION REGARDING |
| Filed: January 22, 2001 | : PATENT TERM ADJUSTMENT |
| Attorney Docket No. 9683/76 | : |
| | : |
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This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705(b)", filed February 6, 2007. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from five hundred eighty-four (584) days to eight hundred twenty-nine (829) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **six hundred fifty-two (652) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On November 2, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is five hundred eighty-four (584) days. On February 2, 2007,

Applicants timely¹ submitted the instant application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is eight hundred twenty-nine (829) days.

Applicants state that the application is not subject to a terminal disclaimer.

The Office determined a patent term adjustment of five hundred eighty-seven (587) days based on an adjustment for PTO delay of eight hundred twenty-one (821) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1) and one hundred ninety-four (194) days pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. § 1.703(a)(2), reduced by Applicants' delays of twenty-nine (29) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b), and seventeen (17), two hundred seventy-two (272), fifty-five (55), and sixty-eight (68) days pursuant to 35 U.S.C. 154(b)(2)(C)(iii) and 37 C.F.R. § 1.704(c)(8). The adjustments of 272, 55, and 68 days are at issue.

With respect to the two hundred seventy-two (272) days of delay assessed, applicants assert that they should have only been assessed delay of one hundred nine (109). Applicants state that the clock should have stopped when they filed a supplemental IDS on April 11, 2005. However, a review of the file indicates that applicants filed an additional supplemental IDS on September 21, 2005. Moreover, § 1.704(d) states that an IDS will not be considered a failure to engage under (c)(8) if it is accompanied by a statement that "each item of information contained in the information disclosure statement was **first** cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by an individual in 1.56(c) more than thirty days prior to the filing" of the IDS.² The IDS filed on September 21, 2005 did not contain a proper 37 C.F.R. § 1.704(d) statement, because it lacked the language of "first cited". Accordingly, applicant delay with respect to this filing was correctly assessed as 272 days.

Similarly, with respect to the fifty-five (55) days of delay assessed, applicants assert that they should have only been assessed delay of forty-one (41) days, because the clock should have stopped when they filed a supplemental IDS on February 13,

¹ Applicants filed the application for patent term adjustment together with the payment of the issue fee.

² Emphasis added.

2006. However, a review of the file indicates that applicants filed an additional supplemental IDS on February 27, 2006. Moreover, the IDS did not contain the proper "first cited" language as discussed above. Accordingly, applicant delay with respect to this filing was properly assessed as 55 days.


With respect to the sixty-eight (68) days of applicant delay, applicants are correct that zero (0) days should been assessed. A review of the IDS filed October 23, 2006 reveals that it did contain a proper 1.704(d) statement, including the language of "first cited". Accordingly, no delay should have been assessed with respect to this filing.

In view thereof, the correct determination of patent term adjustment at the time of mailing of the Notice of Allowance is **six hundred fifty-two (652) days** (1025 (831+194) days of PTO delay, reduced by 373 (17+272+55+29) days of applicant delay.

Receipt of the fee under 37 C.F.R. § 1.18(e) is acknowledged.

The matter is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Day : Sunday
Date: 4/15/2007

PALM INTRANET

Time: 18:48:45

PTA Calculations for Application: 09/744426

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|--------------------------|------------|-------------------------|------|
| Application Filing Date: | 01/22/2001 | PTO Delay (PTO): | 1025 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 441 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 652 |
| PTO Delay Adjustment: | 68 | | |

File Contents History

| Number | Date | Contents Description | PTO | APPL | START |
|--------|------------|--|-----|------|-------|
| 87 | 04/15/2007 | ADJUSTMENT OF PTA CALCULATION BY PTO | 68 | | |
| 74 | 11/02/2006 | MAIL NOTICE OF ALLOWANCE | | | |
| 73 | 10/31/2006 | ISSUE REVISION COMPLETED | | | |
| 72 | 10/23/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 68 | 64 |
| 71 | 10/30/2006 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 70 | 10/30/2006 | NOTICE OF ALLOWABILITY | | | |
| 69 | 05/15/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 68 | 05/15/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 67 | 05/22/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 66 | 05/15/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 65 | 08/24/2006 | DATE FORWARDED TO EXAMINER | | | |
| 64 | 08/16/2006 | RESPONSE AFTER NON-FINAL ACTION | | 29 | 56 |
| 63 | 08/16/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 62 | 05/22/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 61 | 05/15/2006 | MISCELLANEOUS INCOMING LETTER | | | |
| 60 | 05/15/2006 | REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED) | | | |
| 59 | 05/15/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 58 | 05/15/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |

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|----|------------|--|-----|-----|----|
| 57 | 05/15/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 56 | 04/18/2006 | MAIL NON-FINAL REJECTION | | | |
| 55 | 04/07/2006 | NON-FINAL REJECTION | | | |
| 54 | 02/27/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 53 | 02/27/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 52 | 02/13/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 51 | 09/21/2005 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 50 | 03/21/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 49 | 02/27/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 55 | 44 |
| 48 | 02/13/2006 | REFERENCE CAPTURE ON IDS | | | |
| 47 | 02/27/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 46 | 02/13/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 45 | 01/10/2006 | DATE FORWARDED TO EXAMINER | | | |
| 44 | 01/03/2006 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 43 | 01/03/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 42 | 11/03/2005 | MAIL RESTRICTION REQUIREMENT | 194 | | 31 |
| 41 | 10/31/2005 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 40 | 09/21/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 272 | 31 |
| 39 | 03/30/2005 | REFERENCE CAPTURE ON IDS | | | |
| 38 | 03/12/2001 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 37 | 01/22/2001 | REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED) | | | |
| 36 | 04/11/2005 | REFERENCE CAPTURE ON IDS | | | |
| 35 | 04/11/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 34 | 03/30/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 33 | 01/03/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 32 | 04/06/2005 | DATE FORWARDED TO EXAMINER | | | |

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|----|------------|--|-----|----|----|
| 31 | 12/23/2004 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 30 | 12/23/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 29 | 11/18/2004 | MAIL RESTRICTION REQUIREMENT | | | |
| 28 | 11/15/2004 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 27 | 10/25/2004 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 26 | 08/16/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 17 | 21 |
| 25 | 06/21/2004 | REFERENCE CAPTURE ON IDS | | | |
| 24 | 06/21/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 23 | 01/21/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 22 | 09/13/2004 | DATE FORWARDED TO EXAMINER | | | |
| 21 | 07/30/2004 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 20 | 07/30/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 19 | 06/30/2004 | MAIL RESTRICTION REQUIREMENT | 831 | | 3 |
| 18 | 06/28/2004 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 17 | 12/15/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 16 | 08/04/2003 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 15 | 02/10/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 14 | 01/17/2003 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 13 | 06/06/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 11 | 06/12/2001 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 10 | 01/22/2001 | REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED) | | | |
| 9 | 04/18/2001 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 8 | 04/12/2001 | APPLICATION DISPATCHED FROM OIPE | | | |
| 7 | 03/22/2001 | RELEASED TO OIPE | | | |
| 6 | 03/22/2001 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 5 | 02/22/2001 | 371 APPLICATION PREEXAMINATION DOCKETING | | | |
| 4 | 01/30/2001 | 371 APPLICATION PREEXAMINATION DOCKETING | | | |
| 3 | 01/22/2001 | RECEIPT OF 371 REQUEST | | | |
| 2 | 01/30/2001 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 1 | 01/22/2001 | INITIAL EXAM TEAM NN | | | |